



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/717,990

11/21/2003

Horst Heirler

028622-0125

8166

22428

7590

07/27/2006

FOLEY AND LARDNER LLP
SUITE 500
3000 K STREET NW
WASHINGTON, DC 20007

EXAMINER

ROYDS, LESLIE A

ART UNIT

PAPER NUMBER

1614

DATE MAILED: 07/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/717,990	HEIRLER, HORST	
	Examiner	Art Unit	
	Leslie A. Royds	1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-6 and 8-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-6 and 8-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1, 3-6 and 8-19 are presented for examination.

Applicant's Amendment filed May 15, 2006 has been received and entered into the present application. Accordingly, claims 2 and 7 have been cancelled and claims 1, 3, 5-6, 8, 10-12 and 14 have been amended.

In view of the foregoing amendments and remarks made herein, the rejection of claims 14-19 under 35 U.S.C. 112, second paragraph, and the rejection of claim 1 under 35 U.S.C. 102(b) have each been hereby **withdrawn**.

In view of the cancellation of claims 2 and 7, the rejection of such claims under 35 U.S.C. 103(a) has been hereby rendered **moot**.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-6 and 8-19 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Bell et al. (WO 97/38593; 1997) in view of The Merck Index (Monographs 5382, 5383, 6788, 9918 and 9932), Zawistowski et al. (WO 01/91587; 2001), Laughlin et al. (U.S. Patent No. 5,470,839; 1005), Stedman's Medical Dictionary (22nd Edition, 1972; p. 1400), Mendy (U.S. Patent No. 4,407,821; 1983) and DeMichele et al. (U.S. Patent No. 5,780,451; 1998), each already of record, for the reasons of record set forth at pages 8-10 of the previous Office Action

Art Unit: 1614

dated February 13, 2006 and the reasons of record set forth at pages 8-15 of the previous Office Action dated April 27, 2005, of which said reasons are herein incorporated by reference.

Cancellation of claims 2 and 7 has rendered the rejection under 35 U.S.C. 103(a) moot as applied to such claims.

Applicant's traversal has been carefully considered in its entirety, but fails to be persuasive.

In particular, Applicant traverses on the grounds that Bell et al. does not describe the use of linoleic acid, eicosapentaen acid or docosahexaen acid, which are elements required by newly amended present claim 1, and that the Office attempts to remedy this by using the cited reference to Zawistowski et al. (see page 7 of Applicant's remarks) However, Applicant's statement that Zawistowski et al. was relied upon to teach the obviousness of linoleic acid is, in fact, incorrect. Rather, Applicant's attention is directed to page 10 of the Office Action dated April 27, 2005, wherein The Merck Index was relied upon to show that peanut, sunflower or safflower oil contain linoleic acid as a fatty acid component and, thus, the use of any one of peanut, sunflower or safflower oil as taught by Bell et al. as the source of the medium- or long-chain triglycerides would necessarily have also provide linoleic acid.

Applicant maintains at page 7 of the remarks that the use of eicosapentaen acid or docosahexaen acid is not obvious in view of the cited reference to Zawistowski et al. In fact, Applicant asserts that a person of skill in the art would not be motivated to use Zawistowski et al. in order to remedy the deficiency of Bell et al. Applicant states, "Zawistowski described the use of short and medium chain triglycerides in lieu of long chain triglycerides. The main thrust of the Zawistowski publication is to emphasize that long chain triglycerides should not be used in

Art Unit: 1614

the context of the nutraceutical compositions described” and further relies upon claim 1 and the examples provided in Zawistowski.

In response thereto, it is first noted that both Bell et al. and Zawistowski et al. are directed to resolving the same problem of dietary and nutritional supplementation and each teach its suitability for use in diabetic patients. It logically follows that the disclosure and teachings of such a reference would have naturally commended themselves to one of ordinary skill in the art at the time of the invention since each was directed to similar subject matter and, thus, the teachings would have been logically combined with a reasonable expectation of success, absent factual evidence to the contrary.

In support of Applicant’s assertion, however, Applicant alleges that the cited reference to Zawistowski describes the use of short and medium chain triglycerides in lieu of long chain triglycerides, but fails to point to express support in the disclosure of Zawistowski that constitutes, or even suggests, such a teaching. In fact, Zawistowski et al. expressly states to the contrary. Please reference page 5, for example, which states at paragraph 3, “The present invention further provides oil compositions for use in reducing weight gain and maintaining a healthy body weight via the enhanced metabolism of fats and decreased energy expenditure which comprise one or more triglycerides bearing both short and medium chain fatty acid residues derived from fatty acids having from 4 to 14 carbon atoms *and long chain fatty acid residues* derived from fatty acids having from 15 to 22 carbon atoms.” (emphasis added) Such a teaching clearly and unequivocally teaches and contemplates embodiments of the invention wherein long-chain triglycerides are a component of the composition.

Nonetheless, Applicant further submits that the cited reference to Zawistowski emphasizes that long-chain triglycerides should not be used in the context of the nutraceutical composition described (see page 7 of Applicant's remarks) and relies upon claim 1 and the examples in support of this position. However, Applicant clearly has not addressed the teachings of the reference as a whole, which expressly contemplates and teaches the use of compositions wherein long-chain triglycerides are employed (please see the preceding paragraph). Furthermore, Applicant is reminded that the disclosure of a reference is not limited only to that which is preferred or even solely to that which is claimed or exemplified. Applicant is directed to the MPEP at §2123, which states, "A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including non-preferred embodiments...Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or non-preferred embodiments." Thus, it is clear that though the claims and the examples may not expressly recite the use of long-chain triglycerides, the use of such long-chain triglycerides is clearly contemplated by the reference (please reference, for example, pages 4-5 of Zawistowski et al.) and is by no means excluded from use, absent factual evidence to the contrary.

In light of such, it remains that one would have contemplated the use of long-chain triglycerides, such as eicosapentaen acid and/or docosaheptaen acid, for use in the dietary supplement bar for diabetics as disclosed by Bell et al. because Zawistowski et al. teaches the function of short, medium *and* long-chain triglycerides as having efficacy in maintaining proper diet, nutrition and health, and, thus, the inclusion of such long-chain triglycerides in the

Art Unit: 1614

composition of Bell et al. would only serve to enhance the dietary benefit and therapeutic effect of the supplement bar of Bell et al.

Regarding Applicant's statement that the other references taken in total do not remedy the deficiencies of the primary references (see page 7 of Applicant's remarks), it is here once again noted that Applicant continues to argue against the references individually without clearly addressing the context of the combined teachings of all of the references as they were set forth in the rejection. Applicant is again reminded that the references are relied upon in combination and are not meant to be considered separately as in a vacuum. It is the combination of all of the cited and relied upon references that make up the state of the art with regard to the claimed invention. Applicant's claimed invention fails to patentably distinguish over the state of the art represented by the cited references for the reasons described above and those set forth in the previous Office Actions of April 27, 2005 and February 13, 2006. Please reference *In re Young*, 403 F.2d 754, 159 USPQ 725 (CCPA 1968) and *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Furthermore, it is also noted that one cannot show nonobviousness by attacking references individually where the rejections are based upon combinations of references. Please also see *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981) and *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

For these reasons, and those previously made of record at pages 8-10 of the previous Office Action dated February 13, 2006 and the reasons of record set forth at pages 8-15 of the previous Office Action dated April 27, 2005, of which said reasons are herein incorporated by reference, rejection of claims 1, 3-6 and 8-19 remains proper and is **maintained**.

Conclusion

Rejection of claims 1, 3-6 and 8-19 remains proper and is **maintained**.

No claims of the present application are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

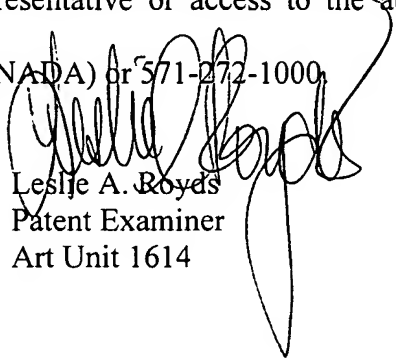
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leslie A. Royds whose telephone number is (571)-272-6096. The examiner can normally be reached on Monday-Friday (9:00 AM-5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin H. Marschel can be reached on (571)-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1614

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Leslie A. Royds
Patent Examiner
Art Unit 1614

July 11, 2006

 7/23/06
ARDIN H. MARSCHEL
SUPERVISORY PATENT EXAMINER